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EXAMINER

CHAMPAGNE, DONALD

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3622

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GROUP 3600

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 09/482,462
Filing Date: January 13, 2000
Appellant(s): ANDERSEN ET AL.

John A. Castellano, Esq.
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 24 May 2004.

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(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences, which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is confused. As noted by appellant, an amendment after final was entered on 23 September 2003. That amendment was entered, as appellant was told it would be in an advisory action mailed on 8 October 2003, which appellant acknowledges at the bottom of p. 8.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1-50 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

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(8) Claims Appealed

A correct copy of appealed claims 1-50 appears on pages 27-43 of the Appendix to the appellant's brief.

(9) Prior Art of Record

US006253188B1

Witek et al.

6-2001

"NEXPO '97, PART II: Editorial and advertising systems, other products", Seybold Report on Publishing Systems, vol. 26 issue 22, 18 August 1997: 7(25).

"QUARK: Quark Publishing System 2.0 to ship with Windows applications and scores of new features", M2 Presswire, 24 March 1998.

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims. This is a verbatim copy of the pertinent parts of the final rejection mailed on 23 May 2003.

Response to Arguments

2. Applicant's arguments filed on 16 April 2003 have been fully considered but they are not persuasive. An explanation is given in para. 18-21 below.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-50 are rejected under 35 U.S.C. 103(a) as obvious over by Witek et al. in view of NEXPO '97.
9. Witek et al. teaches (independent claims 1, 19, 25 and 44) a system and method for advertisement sales and management, the system comprising (Fig. 1) data storage

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and database means 20, retrieval means 14, processing means 16 and 26, and a number of workstations (computer terminals 22), one or more being adapted to entering advertisement orders (col. 5 lines 28-31), the database and data processing means being adapted to store and manage data relating to an advertising customer (user), order, medium or media, schedule, contents and presentation elements (col. 5 lines 28-31; col. 56 lines 8-10; col. 48 line 14; col. 46 lines 7-9; and col. 42 lines 10-16); defining the advertisement on the basis of entered order data (col. 8 lines 60-61); the system and method thereby supporting entry, sale and management of ads in several media (col. 56 lines 8-10) based on entry of a single advertising order.

10. Witek et al. does not teach entry, sale and management of several related ads based on entry of a single advertisement order. NEXPO '97 teaches reusing content (pp. 27 of 40, first full para.), which reads on entry, sale and management of several related pieces of content based on entry of a single piece of content. Because ads, as the source of the bulk of publishing revenue, are important content, and because this convenience would reduce cost and encourage advertising sales, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to combine the teachings of NEXPO '97 with those of Witek et al, so as to provide a single system supporting entry, sale and management of several related advertisements in several publications/media based on entry of a single advertisement order.
11. Witek et al. also teaches claims 2-5, 7, 9, 20-22, 27-30, 32, 34 and 46-48 at the locations indicated above. Witek et al. also teaches: (claims 11, 12, 36 and 37) that the customer agrees with the price of the ad, determined dynamically at the time of the order (col. 56 lines 25-31); (claims 14, 15, 39 and 40) the Internet (title); and (claims 16, 17, 41 and 42) a GUI related to a target media (Fig. 8-10, description beginning at col. 23 line 44).
12. Witek et al. does not teach (claims 23 and 49) editing and re-storing the ad contents and presentation elements. However, under the principles of inherency (MPEP § 2112.02), since the reference invention necessarily performs the method claimed, the method claimed is considered to be anticipated by the NEXPO '97 teaching of content reuse. As evidence tending to show inherency, it is noted that ads are

generally not identical from one publication to the next, requiring some sizing or other editing, and would accordingly have to be re-stored in order to be reused.

13. Witek et al. does not teach the presentation element limitations of claims 6 and 31, but since the reference does teach formatting the presentation for the user (col. 42 lines 15-16), at least some of these presentation element limitations must be inherent. That is, formatting necessarily requires that the ad have a size, that the printed ad have a typeface or font, etc.
14. Witek et al. does not teach (claims 8 and 33) that the physical presentation of the ad is established on the basis of data relating to contents. NEXPO '97 teaches observing content-related restrictions (pp. 13 of 40, last full para.), which reads on establishing the physical presentation of the ad on the basis of data relating to contents. Because advertisers would be very displeased if content-related restrictions were not maintained, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to combine the teachings of NEXPO '97 with those of Witek et al.
15. Witek et al. does not teach (claims 10 and 35) determining price of the ad based on attributes associated the ad. However, the reference does teach presenting the user with rate information (col. 56 line 26). Official notice is taken (MPEP § 2144.03) that it was common, at the time of the instant invention, to determine price of an ad based on attributes such as its size or colors. Because it is efficient to accept common or standard practices, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to determine the price of the ad based on attributes associated the ad.
16. Witek et al. does not teach (claims 18 and 43) modifying the GUI without modifying binary code. The reference invention uses GUI for the user menus (Fig. 8-10, description beginning at col. 23 line 44). Because these menus differ for each participating newspaper (col. 6 lines 22-23) and can be expected to require frequent changes, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to modifying the GUI without modifying binary code.
17. Witek et al. does not teach (claims 13, 24, 38 and 50) a WYSIWYG editor. Because it is ideal for modifying the user menus (para. 12 above), it would have been obvious

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to one of ordinary skill in the art, at the time of the invention, to provide a WYSIWYG editor.

18. Reply to Applicant's arguments (pp. 20-25) – "QUARK" is hereby made of record to address applicant's arguments. This document supports the teachings of NEXPO '97 (para. 6 above), that QPS 2.0 "lets text or pictures in one layout be reused in multiple layouts across different publications" (top of p. 2/2, as marked).
19. Applicant argues (pp. 20-21) that NEXPO '97 teaches accessing rather than outputting to multiple publications, but "reuse" reads on outputting. Applicant also argues that NEXPO '97 reads on multiple publications not multiple media ("several media" in the claims), but later acknowledges (p. 21 middle) that Witek et al. teaches two media (para. 5 above, col. 56 lines 8-10 in the reference). Two media reads on "several media" (Merriam-Webster's Collegiate Dictionary).
20. Applicant argues (p. 23) that the motivation to combine the references, explained in the last action as "... the economic incentive to reduce costs and expand sales", pertains potentially to all businesses. That is true. The remainder of applicant's economic reasoning in pp. 23-24 is based on arguable assumptions.
21. Applicant's example explanation of Witek et al. in the center of p. 24 is correct, but it should be noted that the rejection is based on the combination of two references, not merely on Witek et al. Applicant's explanation of the instant invention "CCI system" on pp. 24-25 does appear to be different from the reference invention (Witek et al. plus NEXPO '97) in suggesting material for "a range of products" as a single input. However, examiner could not find this feature disclosed in the original application, and "product" is not defined in the specification, so it is not clear that the "range of products" distinction is patentable, especially from the current application.

(11) Response to Argument

The rejections under 35 USC 112 referred to at the top of p. 6 and in the middle of p. 8 have been withdrawn. The rejection of claims 1-50 as obvious over Witek et al. in view of NEXPO '97 remains at issue.

Appellant's "argument" on pp. 6-12 is a discussion of the references and a recapitulation of the final rejection presented above. Since appellant's "summary" covers six pages, the following briefer summary of the rejection might be helpful.

All the independent claims 1, 19, 25 and 44 have been rejected principally against Witek et al. The rejection (para. 9-10 above) argues that Witek et al. teaches every feature except one. The appellant has not disputed this allegation.

It is agreed that Witek et al. does not teach entry, sale and management of several related ads based on entry of a single advertisement order. To rectify this deficiency, the rejection (para. 10 above) notes that NEXPO '97 teaches reusing content (pp. 27 of 40, first full para.), and alleges that this reads on entry, sale and management of several related pieces of content based on entry of a single piece of content.

Appellant disputes this allegation (p. 13, first full para. to the top of p. 14). However, appellant has no substantive argument. It is a matter of judgment as to whether or not the teaching in NEXPO '97 reads on entry, sale and management of several related pieces of content based on entry of a single piece of content. For the convenience of the Board, the subject paragraph from NEXPO '97 (pp. 27 of 40, first full para.) is as follows.

“• **Reuse content** -- easier production of multiple publications or types of documents- through a function called Multilinking. It will be possible to attach a single text or picture file to more than one Xpress layout, which makes it easier to reuse content in multiple publications, such as in zoning. If a change is later made to this file in one of its uses, that copy immediately becomes a different file and the changes don't apply to the other places it is used.” (NEXPO '97, p. 27 of 40, first full para.)

Note that this passage expressly teaches reusing content in multiple publications. Appellant disputes this specific point (p. 14, first full para.), but it is patent and beyond dispute.

Also see Quark, a reference made of record to address appellant's arguments. Quark provides some additional detail in support of the brief passage in NEXPO '97 (para. 18 and 19 of the above rejection).

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Appellant also argues that there is insufficient motivation to combine NEXPO '97 with Witek et al. (p. 14, "Motivation Argument" and again at p. 17). The motivation (para. 11 of the above rejection) is economy. One of ordinary skill in the art, at the time of the invention, would have appreciated the enormous potential savings in both time and money of being able to reuse content across many publications. Appellant would have the Board believe that this basic economic wisdom could come only from knowledge of the instant application.

Applicant argues (bottom of p. 15) that the QPS 2.0 software taught by NEXPO '97 is not combinable with the invention of Witek et al., but provides no supporting evidence. At the top of p. 16, appellant alleges "QPS has no knowledge – or capabilities for – generating sales, entry or management data in the order process". Appellant has no evidence of that. What appellant means is that the examiner has made only a *prima facie* case. Whether or not it is a complete and adequate *prima facie* case the Board will have to judge. But, appellant does not go beyond the examiner's *prima facie* case to produce evidence that would disprove it.

On p. 18 the appellant refers to a declaration filed (and entered) as Paper No. 20 on 23 March 2004. The examiner did consider this after-final submission and found that it did not put the claims in condition for allowance because it, again, did not submit evidence sufficient to overcome the examiner's *prima facie* case of obviousness.

This is a case of technical fact more so than law. At central issue is what the QPS 2.0 software was and was not capable of at the time it was described in the NEXPO '97 and QUARK references. The examiner has interpreted the references to indicate that the NEXPO '97 passage reads on entry, sale and management of several related pieces of content based on entry of a single piece of content. If the examiner's has misunderstood this admittedly slim evidence, it should readily be possible to develop new information showing that the QPS 2.0 software of NEXPO '97 vintage was not capable of doing that, and especially that it could not readily be combined with the teachings of Witek et al.

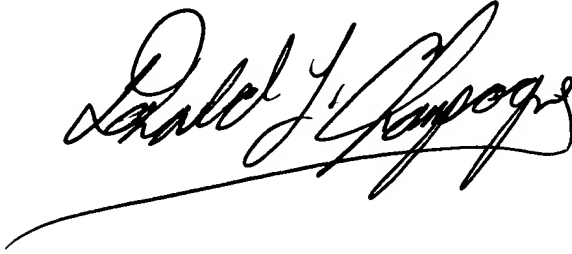
The appellant has not done that. The appellant has submitted opinions that the rejection is wrong, but nothing that qualifies as new technical evidence. The appellant has failed to meet his burden to provide evidence. The *prima facie* rejection should be affirmed.

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On pp. 19 and 20 appellant repeats for independent claims 19, 25 and 44 arguments made previously for independent claim 1.

On pp. 21-24 applicant argues that dependent claims are not obvious. The claims add limitations that, in most cases, would be obvious even without references.



For the above reasons, it is believed that the rejections should be sustained.



Respectfully submitted,

Donald L. Champagne
Examiner
Art Unit 3622

9 June 2004

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